

The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

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PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEVEN T. KIRSCH

Appeal No. 2002-0368
Application 08/927,022

ORDER REMANDING TO EXAMINER

Effective April 21, 1995, 37 CFR § 1.192(c)¹ was amended to provide as follows (underlining added for emphasis):

(c) The brief shall contain the following items under appropriate headings and in the order indicated below unless the brief is filed by an applicant who is not represented by a registered practitioner:

(1) *Real party in interest.* A statement identifying the real party in interest, if the party named in the caption of the brief is not the real party in interest.

(2) *Related appeals and interferences.* A statement identifying by number and filing date all

¹ 60 Fed. Reg. 14518 (Mar. 17, 1995), 1173 Off. Gaz. Pat. & Trademark Office 62 (Apr. 11, 1995).

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other appeals or interferences known to appellant, the appellant's legal representative, or assignee which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal. (underlining added for emphasis).

The Appeal Brief filed July 2, 2001 (Paper No. 16) is defective under 37 CFR § 1.192(d) because it fails to comply with the provisions of the rule pertaining to "related appeals and interferences."

The Manual of Patent Examining Procedure (MPEP) § 1206 (6th ed., rev. 1, no. 1, Sept. 1995) states:

If appellant does not name a real party in interest, the examiner will assume that the party named in the caption of the brief is the real party in interest, i.e., the owner at the time the brief is being filed. . . .

. . . While the examiner will assume that the real party in interest is the individual or individuals identified in the caption when the real party in interest is not explicitly set out in the brief, nevertheless, the Board may require the appellant to explicitly name the real party in interest.

The MPEP § 1206 further states:

If appellant does not identify any other appeals or interferences, the examiner will presume that there are none. While the examiner will assume that there are no related cases when no related case is explicitly set out in the brief, nevertheless, the Board may require the appellant to explicitly identify any related case.

The examiner may presume that the real party in interest is the party named in the caption of the brief and that there are no

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related appeals and interferences, if appellant presents the headings but fails to provide the corresponding statements under the headings. Nevertheless, the examiner is encouraged to request from appellant not only the required headings but also explicit statements naming the real party in interest and identifying any related appeals and interferences in order to avoid further delays in the appeal process, since the Board will otherwise require appellant to explicitly identify the real party in interest and any related appeals and interferences.

In addition, appellant filed a Reply Brief on January 17, 2002 (Paper No. 18) in response to the Examiner's Answer entered on August 27, 2001 (Paper No. 17). However, there is no indication on the record whether or not the examiner has responded to the Reply Brief. Section 1208.03 of the Manual of Patent Examining Procedure (7th ed., July 1998) states:

[A]ppellant may file a reply brief as a matter of right within 2 months from the mailing date of the examiner's answer. . . . The primary must then either: (A) acknowledge receipt and entry of the reply brief by using form paragraph 12.47 on form PTOL-90; or (B) reopen prosecution to respond to the reply brief. See MPEP § 1208.02.

Accordingly, it is

ORDERED that the application is remanded to the examiner

(1) for resolution of the issues set forth above regarding "related appeals and interferences;"

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(2) for proper response to Reply Brief, or to reopen
prosecution; and

(3) for such further action as may be deemed appropriate.

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By:



KIMBERLY JORDAN

Program and Resource Administrator
(703) 308-9797

KJ:clm

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Thomas Schneck
P.O. Box 2-E
San Jose, CA 95109-0005